

Application No. 10/523,237  
Amendment dated May 13, 2010  
Response to Office Action of November 13, 2009

### **REMARKS**

Claims 1 to 6, 8 to 10, 12 to 15, 18 to 27 are presently pending in the subject patent application, and stand rejected under 35 USC 102(b) as being anticipated by Rakavy (US 5,913,040). As will become apparent, the Applicant has amended the claims, as set out above, for clarification purposes only, not for the purpose of distinguishing over the cited reference. No subject matter has been added.

The Applicant maintains that the invention of independent Claims 1, 4, 8 and 12 is not anticipated by Rakavy. It is well established that to anticipate a claim under 35 USC 102(b), a single prior art reference must expressly or inherently teach each and every claim limitation. Moreover, inherency requires the Examiner to prove necessity. If the element is not necessarily present, then that element is not inherent (e.g. MEHL/Biophile Int'l Corp. v. Milgraum, 192 F.3d 1362, 1365, 52 USPQ2d 1303, 1305 (Fed. Cir. 1999), quoted in re Cruciferous Sprout Litigation, 64 USPQ2d 1202, 1206 (Fed. Cir. 2002)).

As the Applicant will demonstrate, Rakavy does not disclose explicitly, or inherently:

- (i) a content database of records each defining an item of auxiliary content, and a respective broadcast space for delivery of the associated auxiliary content item, each said broadcast space comprising a respective time slot, the time slot associated with each said auxiliary content item defining a time frame for the delivery of the associated auxiliary content item; or
- (ii) content selection means in communication with the content database for selecting one of the items in accordance with a correlation between the broadcast spaces and a time instant of issuance of the request from the client terminal and a networked computer accessed by the client terminal.

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(i) Rakavy does not describe a database of records each defining an item of auxiliary content, and a respective broadcast space for delivery of the associated auxiliary content item, each said broadcast space comprising a respective time slot, the time slot associated with each said auxiliary content item defining a time frame for the delivery of the associated auxiliary content item

In the Applicant's submission filed August 11, 2009, the Applicant submitted that Rakavy does not describe a broadcast space segregated into time slots, the time slot associated with each said auxiliary content item defining a time frame for the delivery of the associated auxiliary content item. The Applicant pointed out that, at col. 3, lines 4 to 8 and lines 34 to 37, Rakavy states that messages are downloaded from a remote computer to a local computer based on a user's selection of advertisement or Information categories, and that the users may enter their preferences by directly choosing categories of advertising or other informational content which most interest them. The Applicant also pointed out that, at col. 7, line 51 to col. 8, line 3, Rakavy states that the Scheduler 265 sends the user preferences, user statistics and feedback information to the Advertising System Server 600, and that the Polite Agent 280 is responsible for monitoring the communications line utilization rate and transmitting the data during times of low communications line utilization. Therefore, the Applicant submitted that, in these passages, Rakavy does not disclose that the Advertising System Server 600 maintains a database comprising a broadcast space segregated into time slots, the time slot associated with each advertisement defining a time frame for the delivery of the associated advertisement.

In the Office Action mailed November 13, 2009, the Examiner replied to the Applicant submissions, stating that "Rakavy teaches an advertisement is displayed during idle time as a screen saver, the screen saver subsystem tracks user interaction with the system and when the screen saver subsystem detects that the system has been idle, for example when there has been no user interaction with the computer for a

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preconfigured time, it activates the advertisements display manager which will select an advertisement and display it". The Applicant respectfully submits that the Examiner's reply does not respond to the substance of all of the Applicant's submissions.

In the Applicant's submission filed August 11, 2009, Claim 1 recited "a content database of records each defining an item of auxiliary content, and a broadcast space for delivery of the associated auxiliary content item, the broadcast space being segregated into time slots, the time slot associated with each said auxiliary content item defining a time frame for the delivery of the associated auxiliary content item." In the instant Office Action, the Examiner clearly admits that Rakavy discloses that the screen saver subsystem activates the advertisements display manager, not based on a time slot defined in a database, but when the system has been idle. Although Rakavy discloses that the screen saver subsystem activates the advertisements display manager after a preconfigured time of inactivity, the time frame for the delivery of the advertisement is based entirely on the (in)activity of the user and, therefore, is not equivalent to a time slot defined in a database.

More importantly, Rakavy does not disclose that the Advertising System Server 600 or the screen saver subsystem maintains a database of records, each defining a respective broadcast space, each broadcast space comprising a respective time slot defining a time frame for the delivery of the associated advertisement. As the Examiner observed, Rakavy discloses that the Polite Agent 280 downloads the advertisements to the user's local computer when the local computer is idle. Further, as the Examiner noted, the advertisements display manager is activated after a preconfigured period of user inactivity, not based on a time slot defined in a database.

Although Rakavy discloses that the Polite Agent 280 may download the advertisements based on user preference information (that specifies time periods and types of foreground activities during which advertisements may be transmitted), nothing in

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Rakavy suggests that each item of user preference information is associated with a specific advertisement, or that such an association is necessary. Therefore, Rakavy does not describe, expressly or implicitly, a database of records each defining an item of auxiliary content, and a respective broadcast space for delivery of the associated auxiliary content item, each said broadcast space comprising a respective time slot, the time slot associated with each said auxiliary content item defining a time frame for the delivery of the associated auxiliary content item, as required by independent Claims 1, 4, 8 and 12 of the subject patent application.

(ii) Rakavy does not describe content selection means in communication with the content database for selecting one of the items of auxiliary content in accordance with a correlation between the broadcast spaces and a time instant of issuance of a request from the client terminal for auxiliary content and a networked computer accessed by the client terminal

In the Applicant's submission filed August 11, 2009, the Applicant submitted that Rakavy does not describe selecting an item of auxiliary content in accordance with a correlation between broadcast spaces and a time instant of the issuance of a request from a client terminal for the auxiliary content. The Applicant pointed out that, at col. 2, line 66 to col. 3, line 14, and col. 9, lines 47 to 49, Rakavy states that messages are downloaded from a remote computer to a local computer based on a user preference information such as time periods and types of foreground activities during which advertisements and feedback information may be transmitted. The Applicant also pointed out that, at col. 3, lines 52 to 63 and at col. 7, lines 51 to 61, Rakavy states that the Scheduler 265 sends the user preferences to the Advertising System Server 600, and that the Pollte Agent 280 is responsible for monitoring the communications line utilization rate and downloading the advertisements to the user's local computer during times of low communications line utilization.

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Therefore, the Applicant submitted that, in these passages, Rakavy does not disclose that the Advertising System Server 600 selects the advertisements based on a correlation between each advertisement's time slot and a time instant of the issuance of the request for an advertisement. Instead, Rakavy only discloses that the Advertising System Server 600 selects the advertisements based on user preference information that is transmitted to the Advertising System Server 600, and that the Polite Agent 280 downloads the selected advertisements to the user's local computer based on user preference information.

In the Office Action mailed November 13, 2009, the Examiner replied to the Applicant submissions, stating that "Rakavy discloses a Polite Agent Technology current used to download advertisement in the background during low line utilization can be modified to receive current data such as news and stock quotes (col. 14-15, lines 60-27). Furthermore, an alternate embodiments and modification to the Polite Agent Technology, it is by basic algorithm, able to download and display advertisement at the instant the user requests the content". The Applicant respectfully submits that the Examiner's reply again does not respond to the substance of the Applicant's submissions.

As the Applicant also explained in its submission filed August 11, 2009, although Rakavy disclosed that the Polite Agent 280 could be modified to receive other types of information content, Rakavy does not teach or suggest that the Advertising System Server 600 selects the appropriate advertisement based on a time slot specified in user preference information or such other information content. Instead, Rakavy discloses that the user preference information may specify time periods and types of foreground activities during which advertisements may be transmitted to the local computer. Since Rakavy also discloses that the Polite Agent 280 is only responsible for downloading the advertisement to the user's local computer, it is implicit in the Rakavy disclosure that the Polite Agent 280 merely uses the time periods specified in the user preference

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information to determine the appropriate time to download (not select) each advertisement.

Moreover, although Rakavy discloses that user preference information may include time periods and types of foreground activities during which advertisements and feedback information may be downloaded, nothing in Rakavy suggests that the Advertising System Server 600 selects advertising content based on time periods specified in the user preference information or based on other information content. The Examiner did not respond to this submission.

Although the Examiner also asserted that the Polite Agent algorithm was able to download and display advertisements at the instant the user requests the content, the Applicant pointed out that the Examiner failed to identify any particular passage in Rakavy that would support such an interpretation. The Applicant also submitted that such an interpretation would be inconsistent with one of the objects described by Rakavy, namely to provide advertisements and/or informational message from a network to a local computer with minimal interference with other data being transmitted between the network and the local computer (see col. 3, lines 9 to 14). To realize this object, Rakavy disclosed that the Polite Agent 280 transmits the data between the network and the local computer during times of low communications line utilization (see col. 7, lines 51 to 61). Since downloading advertisements to the local computer over a communication line at the very instant the user transmits a request for content over the communication line would be inconsistent with downloading the content during times of low communications line utilization, the Applicant respectfully submitted that the Examiner erred by concluding that Rakavy made such a teaching. The Examiner did not respond to this submission.

More importantly, Rakavy does not disclose that the Advertising System Server 600 or the Polite Agent 280 selects one of the advertisements in accordance with a correlation

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between broadcast spaces (defined in a database and segregated into time slots, the time slot associated with each advertisement defining a time frame for the delivery of the associated advertisement) and a time instant of issuance of a request from a client terminal for an advertisement and a networked computer accessed by the client terminal. As mentioned, although Rakavy discloses that user preference information may include time periods and types of foreground activities during which advertisements and feedback information may be downloaded, nothing in Rakavy suggests that each item of user preference information is associated with a specific advertisement and specifies a time frame for the delivery of the associated advertisement, or that such an association is necessary. Further, nothing in Rakavy suggests that the Advertising System Server 600 selects advertising content based on time slots specified in such user preference information or on other information content, or that time slot data is present in such information as a matter of necessity. Therefore, Rakavy does not describe, expressly or implicitly, content selection means for selecting one of the items of auxiliary content in accordance with a correlation between broadcast spaces (defined in a database and segregated into time slots, the time slot associated with each advertisement defining a time frame for the delivery of the associated advertisement) and a time instant of issuance of a request from the client terminal for auxiliary content and a networked computer accessed by the client terminal, as required by independent Claims 1, 4, 8 and 12 of the subject patent application.

Summarizing the foregoing submissions, Rakavy does not teach:

(I) a content database of records each defining an item of auxiliary content, and a respective broadcast space for delivery of the associated auxiliary content item, each said broadcast space comprising a respective time slot, the time slot associated with each said auxiliary content item defining a time frame for the delivery of the associated auxiliary content item; or

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(ii) content selection means in communication with the content database for selecting one of the items in accordance with a correlation between the broadcast spaces and a time instant of issuance of the request from the client terminal and a networked computer accessed by the client terminal.

Therefore, the Applicant submits that the invention of independent Claims 1, 4, 8 and 12 is not anticipated by Rakavy.

Since Claims 2, 3, 5, 6, 9, 10, 13, 14, 15, and 18 to 27 depend from one of independent Claims 1, 4, 8 and 12, the foregoing submissions apply equally to Claims 2, 3, 5, 6, 9, 10, 13, 14, 15, and 18 to 27. Therefore, the Applicant respectfully requests that the Examiner withdraw the 35 USC 102(b) rejection that the Examiner maintained against Claims 1 to 6, 8 to 10, 12 to 15 and 18 to 27.

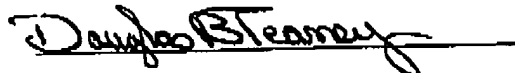
In view of the foregoing, Applicant respectfully submits that all of the Examiner's bases for rejection of the claims should be deemed overcome. Therefore, reconsideration of the application, and allowance thereof, including all of claims 1 – 6, 8 – 10, 12 – 15 and 18 – 27, are respectfully solicited.



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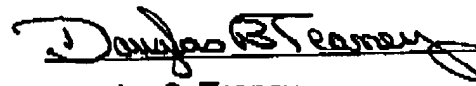
Should anything further be required, a telephone call to the undersigned, at 312-456-8400, is respectfully requested.

Date: May 13, 2010

  
Douglas B. Teaney, Reg. No. 33459

**CERTIFICATE OF TRANSMISSION**

I hereby certify that this PRELIMINARY AMENDMENT is being deposited with the United States Postal Service as first class mail, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, or is being facsimile transmitted to the USPTO, at fax number 571-273-8300, on May 13, 2010.

  
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One of Attorneys for Applicant